

PRE-APPEAL REQUEST FOR REVIEW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:)
Uhlik et al.) Examiner: Naghmeh Mehrpour
Application No: 09/753,266) Art Unit: 2617
Filed: December 29, 2000) Confirmation No.: 1475
For: CHANNEL ALLOCATION BASED ON)
RANDOM PLUS PLANNED PROCESSES)
_____)

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Commissioner for Patents
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Alexandria, VA 22313-1450

In response to the Final Office Action mailed January 6, 2009, and in conjunction with the Notice of Appeal filed concurrently herewith, Applicants respectfully request review of the Final rejection of the claims of the above referenced application in view of the following.

REMARKS

Claims 1-91 are pending in the above-referenced patent application, of which claims 1, 16, 34, 36, 41, 60, 63, and 64 are independent claims. These independent claims are the main subject of this Request. These claims were finally rejected in the Final Office Action of January 6, 2009, under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Number 5,687,171 of Shin et al. (hereinafter "Shin"). The dependent claims were further rejected under 35 U.S.C. § 103 based on Shin in various combinations with various other references, namely, U.S. Patent Publication No. 2002/0072348 of Wheeler et al. (hereinafter "Wheeler"), U.S. Patent Publication No. 2002/0087740 of Castanho et al. (hereinafter "Castanho"), U.S. Patent Publication No. 2003/0163393 of Mittal et al. (hereinafter "Mittal"), U.S. Patent No. 5,680,398 of Robinson (hereinafter "Robinson"), U.S. Patent No. 6,006,084 of Miller et al. (hereinafter "Miller"), U.S. Patent Publication No. 2002/0065081 of Barany et al. (hereinafter "Barany"), and U.S. Patent No. 5,345,549 of Buchenhorner et al. (hereinafter "Buchenhorner").

The rejection of the claims is improper at least because the Office appears to agree in the Final Office Action that the Office's basis for rejection under Shin is missing. And yet the rejection was maintained, instead of the claims allowed.

Regarding the history of this case, Applicants note that the claims have previously been rejected by the Office in a 103 rejection under Shin and Robinson. That rejection was dropped without amendment of Applicants' claims. However, in a good faith effort to expedite prosecution, Applicants elected later to amend the claims in response to other rejections. After many rejections and an Appeal, the Office elected to reopen prosecution and take the case out of Appeal. The rejection was a 102 rejection based on Robinson alone, which Applicants traversed. The Final Office Action to Applicants' Response is the final rejection under Shin alone. Whether asserted alone or in combination, the references fail to support a rejection of Applicants' claims.

Regarding the rejection itself, Applicants quote the following from the "Response to Arguments" section of the Final Office Action, the Office declares Applicants' arguments to be "not persuasive," and then states: "In response to the applicant's argument that 'claims 1, and 64, receiving a random access request on a first random traffic channel which is not designated as a random access channel (sic).' The Examiner asserts that Shin does not disclose that the first traffic channel is a random access channel."

The Final Office Action then further makes a statement on the standards for obviousness, which are asserted to not require bodily incorporation from one reference to another. That is the entirety of the Office's Response.

As a first matter, Applicants acknowledge that the Final Office Action appears to separately reject the different independent claims that have different language. However, as from the Office's Response above, only independent claims 1 and 64 are mentioned. No response is made as to the rejection and Applicants' remarks and arguments with respect to the other independent claims.

Furthermore, the Office's assertion is a bare assertion not supported by the reference. The Office asserts that Shin does not disclose that the first traffic channel is a random access channel. Applicants have never asserted that Shin discloses a first traffic channel that is a random access channel. Rather, Applicants recite Applicants' claims 1 and 64 directed to receiving a random access request on a first random traffic channel that is not a random access channel, and note that Shin fails to disclose how its request is received. Thus, the Office is necessarily relying on the doctrine of inherency. The entire section of Shin discussing allocating channels as relied on by the Office discloses the following:

In step S101, the control unit (105) of a base station reads the strength of a signal that has been measured and provided at an output of the unit (102) for measuring the strength of a signal received during an interval that is shorter than that requested by a call. For example, it can be about 10% of the average call arrival interval.

In step S102, the margin allowed for signal strength is calculated by subtracting the size of a received signal that has been read from the total interferences allocated by the network.

In step S103, the evaluation on whether a new radio channel has been requested is made and if not, step S101 is carried out. **If the evaluation result shows that a request has been made**, the operation proceeds to step S104. In step S104 an evaluation is made on whether the signal strength required for allocating radio channels according to the channel request made in step S103 exceeds the limit of the margin calculated in step S102.

When the evaluation result shows that the margin is more than the required power strength in step S104, corresponding channel processors among channel processors (104A.sup..about. N) should be controlled in order to allocate a radio channel, while carrying out step S105. If the evaluation result shows that the margin is less than the required power strength in step S104, the allocation request of a corresponding radio channel is rejected in step S106.

Emphasis added. As seen from the section of the reference, the "how" the request is received is not disclosed, nor is it considered. The point of the disclosure in Shin is not how the request is received, but whether sufficient power is available to allocate a new channel in response to a request.

Inherency requires that the teachings **necessarily flow** from the disclosure of the reference relied upon. See MPEP § 2112. Applicants submit that a single statement that a request is received is not sufficient basis to show that the request is necessarily received on a traffic channel. To the contrary, one of skill in the art would necessarily presume that the request is received in the traditional manner of receiving the request on a random access channel. Observe that the receiving signal is illustrated in Figure 1 of Shin as being received on the left side of the figure, while the channels for traffic are all on the right side.

Additionally, seeing that Applicants' arguments with respect to independent claims 16, 41, 60, and 63 (reciting features directed to **a request on an unallocated traffic channel**), and claims 34 and 36 (reciting features directed to **a request on any random one of a plurality of traffic channels**), must also necessarily flow from the above section in Shin, seeing that is the section relied on to reject those claims as well. So according to the Office, not only does the statement from Shin "the evaluation on whether a new radio channel has been requested is made," **necessarily show** that a random access request on a first random traffic channel that is not a random access channel, as in claims 1 and 64, but the statement also **necessarily shows** a request on an unallocated traffic channel, as in claims 16, 41, 60, and 63, as well as **necessarily showing** a request on any random one of a plurality of traffic channels, as in claims 34 and 36.

Applicants submit that the Office continues to fail in its duty to provide a *prima facie* case of anticipation or obviousness of Applicants' claimed invention.

As previously argued by Applicants, Shin discusses receiving a request for a channel and measuring signal strength to determine whether to allocate a channel. See col. 3, line 42 to col. 4, line 14 and Figure 2. However, the reference fails to disclose a channel request on **a random traffic channel**, or a channel request on **an unallocated channel**. The reference is silent on the manner in which channel/access requests are received, which is evidence of the fact that the reference uses a traditional, dedicated channel approach, as would be understood by those skilled in the art.

Furthermore, as Applicants have understood the secondary references, none is cited as curing the deficiencies pointed out above, and indeed all references appear to be similarly defective in failing to disclose or suggest requests on a traffic channel. Thus, each reference must necessarily be defective with respect to the features pointed out above, regarding traffic channels not designated as random access channels, unallocated channels, or any random one of a plurality of traffic channels.

Therefore, whether alone or in combination, the cited references fail to disclose or suggest at least one feature of the invention as recited in Applicants' independent claims, and so fail to support the bases of rejection asserted in the Final Office Action. Applicants therefore respectfully request that the rejection of these claims be withdrawn.

Therefore, Applicants submit that the rejection as set forth in the Office Actions is improper. Applicants respectfully request that the rejection be withdrawn and the claims allowed.

Respectfully submitted,
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I hereby certify that this correspondence is being submitted electronically via EFS Web on the date shown below.

Date: April 2, 2009

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